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10/517,492

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Theo Burchard

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11/14/2008

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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SUITE 800

WASHINGTON, DC 20005

EXAMINER

JOY, DAVID J

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

11/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No. 10/517,492	Applicant(s) BURCHARD, THEO	
	Examiner David J. Joy	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 and 3-19 are pending as amended on July 24, 2008, with Claim 2 having been cancelled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

3. Applicant's cancellation of Claim 2, filed on July 24, 2008, renders the previously cited rejection under 35 U.S.C. §103 moot. As such, the rejection of Claim 2 under 35 U.S.C. §103(a) as being unpatentable over the U.S. Patent of Edwards (5,093,184) in view of the U.S. Patent of Pollock (3,601,913) and/or the U.S. Patent of Solomon et al. (4,536,016; hereinafter "Solomon") has been withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 6 and 7 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites that the two foils are to be

exactly registered, whereas in other claims, the phrase *in register* is recited to describe the alignment of the two foils (emphasis added). As it would be impossible to achieve absolute perfection in the registration of the two foils, it is unclear as to how the method step in Claim 6, namely the use of a tension group, can achieve this, as opposed to being able to achieve precise registry.

5. Claim 7 stands rejected accordingly, as it depends upon Claim 6.

Claim Rejections - 35 USC § 102

6. Claims 12-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Edwards.

7. Edwards teaches a multilayer security element having two carrier foils that have security features thereon that only partially cover the foil, and that the carrier foils are joined so that the security features are in precise register to each other (see Abstract; see also Figure 12; see also Column 2, Lines 1-27; see also Column 8, Lines 18-30). Edwards also teaches that the carrier foils have register marks, which are different features than the security features provided by the foils (see Column 2, Lines 11-48). Specifically, Edwards provides that the security element contains two metallic areas, which are

visually detectable (*Id.*). Additionally, when the security element is viewed in reflected light, there is a repeating pattern along the length of the element that is visible and that appears to be in several different colors (see Column 2, Lines 11-48; see also Column 3, Lines 18-42; see also Column 4, Lines 14-28; see also). Further, Edwards teaches that the multilayer security element can be a strip or thread, that the element is embedded within a security paper, and that the security paper can be used to make bank notes, checks, and other similar documents (see Abstract; see also Column 1, Lines 5-18 and 64-68; see also Column 4, Lines 60-63).

Claim Rejections - 35 USC § 103

8. Claims 1 and 3-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, in view of Pollock and Solomon.

9. Edwards teaches a security element having a multilayer structure that contains at least two security features that are aligned so as to be in register with each other, and that the security features are used as register marks, in that it's the appearance of the two security features in visible windows that dictates the authenticity of the security element (see Abstract; see also Figure 12; see also Column 2, Lines 1-48). Edwards also recites the degree of precision achieved through the assembly of the multilayer security

element (see Column 2, Lines 28-48). In addition, Edwards provides that it is widely known to use security devices that are in strips or threads, and that these strips can be slit into individual security elements from a web (i.e., a “so-called endless thread or endless strip”) (see Column 1, Lines 5-18; see also Column 2, Lines 56-66). However, Edwards is silent as to some of the particular aspects dealing with making the security element. Pollock, which is drawn to a magnetic transaction card, and Solomon, which is drawn to banknotes, both provide additional details that could be employed in making the multilayer structure in Edwards. Pollock, teaches a method for producing a multilayer structure that having two security features (“layers of magnetic powder, M1 and M2) and register marks (“sprocket holes”) which are integral in achieving the precise alignment of the multilayer structure (see Column 2, Line 62 – Column 3, Line 7). Pollock also teaches that the layers are assembled under a constant tensile stress, which is provided by pressure rollers, and that the register marks control the alignment of the layers as they move through the pressure rollers (*Id.*). Pollock also recites that the layers are advanced a predetermined distance when they are drawn off the rollers, so that heat sealing elements can engage the multilayer cards and effectuate proper sealing in the longitudinal direction of the card, beginning with the leading edge of the card and continuing to the trailing end (*Id.*). Consequently, it would have been obvious to a skilled artisan to not only ensure proper sealing of the multilayer card by slowing the

roller down once the heat sealing elements engage the material, but also that as the heat sealing is occurring, that the heated material would, in fact, be stretched in the direction that the card is advancing through the elements.

10. Solomon teaches that to make a security element made up of a multilayer structure, the structure having at least two carrier foils and register marks that appear in windows on the surface of the note (as was provided in the multilayer security element taught by Edwards), the basic steps of orienting the foils in both the transverse and longitudinal directions are necessary (see Column 2, Lines 34-49). Additionally, Solomon teaches that windows of the notes provide for the proper and precise alignment of the carrier sheets (see Column 4, Lines 27-40). In addition, with these windows acting as register marks on the surface of the multilayer structure, it is their presence that can be detected by a detector in order to ensure the precise registration as well as make any adjustments to compensate for the any slight variations that might appear or as a result of the constant stretching (see Column 4, Line 65 - Column 5, Line 17). Solomon also teaches that the security devices need not be formed as discrete entities on the transfer foil but may, with advantage, be formed as a continuous optically variable coating on the foil, portions of which may be transferred into the substrate at predetermined locations thereon (see Column 2, Lines 50-68). Finally,

Solomon teaches that from the continuous web/roll of the multilayer structure, a completed security element (i.e., a bank note with the security device firmly bonded thereto) can be produced (see Column 5, Lines 18-29). As Edwards, Pollock and Solomon are all drawn to the same field of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to make the multilayer security element taught by Edwards, and that given the end result recited by Edwards, the details provided by Pollock and Solomon could have been used in order to achieve that end result.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d

2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

12. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

13. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 12-19 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-5, 16, 18-20 and 24 of copending Application No. 2005/0012326. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a multilayer security element having two foils that are aligned in

register, and that the foils also provide additional security features (i.e., the gaps that are present) over that which is provided by the foils. The copending application also claims that the security element can be label or thread that is embedded in a security paper, and that the embedded security paper can be used to produce a document of value (i.e., a bank note). The difference between the copending application and that which is presently claimed is that the present claims feature "register marks" in the security element. However, the register marks are meant to provide additional security to the document, and the gaps/contours taught in the copending application provide the same feature.

15. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

16. Applicant's arguments filed July 24, 2008 have been fully considered but they are not persuasive.

17. Applicant argues that the rejection of Claims 6 and 7, as being indefinite under 35 U.S.C. §112, second paragraph, is improper and the claims should be allowed. First,

it is noted that the rejection is proper, given that the rejection clearly states both that the claim is *indefinite for failing to point out and distinctly claim the subject matter which applicant claims as the invention*, and the claim language is *unclear*. That said, the rejection of the claims as being indefinite stands because the use of the claim language "exactly registered" and the accompanying definition to which Applicant cites in the argument still fails to properly clarify what the claim means by the foils being *exactly registered*. It is also noted that the definition provided in the specification compounds the problem, since Applicant is trying to define terminology that is indefinite using such vague terminology as "within a still acceptable range". It is unclear what would connote an *acceptable range*, and to what degree that range would be *still acceptable*.

18. Applicant also argues that the teachings of Edwards do not provide that the two carrier foils are joined such that the security features are disposed in register to each other. However, that is not the case when it comes to the Edwards reference. According to Merriam-Webster's, *in register* means that the foils are in "a condition of correct alignment or proper relative position". Looking to Edwards, it is clear from the Figures that the two carrier foils are *in register to each other*, because they are shown to be in correct alignment to each other, or in a proper relative position to each other. As for the assertion that Edwards fails to explain how to register the security element, such an

argument is addressing a process limitation (i.e., like in Claim 1), whereas Claim 12 is drawn to an article. Therefore, that argument carries no weight and will not be addressed.

19. Applicant further argues that Pollock does not disclose or suggest that the magnetic security features are disposed in register to each other, and that Pollock does not disclose or suggest the controlling of one of the plastic materials by stretching the plastic material in the longitudinal direction. However, Pollock provides that the magnetic security features are in correct alignment to each other, and that once they are in their proper relative positions, the card that includes the positioned security features, is kept in proper alignment using the sprocket holes as register marks that guide the security features that are contained on the card so that they maintain the correct alignment as the plastic material is positioned thereon. As for the assertion that Pollock does not disclose stretching the plastic material in the longitudinal direction, Pollock was not cited to for its teaching of the longitudinal stretching. It is noted that while Pollock does not disclose all the features of the present claimed invention, Pollock is a teaching reference for the provision of the use of the sprocket holes as register marks to achieve the correct alignment of the multilayer structure, and as it is used as a teaching reference, it is therefore not necessary for this secondary reference to contain all the

features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 U.S.P.Q. 224, 226 (C.C.P.A. 1973); *In re Keller* 624 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

Rather, this reference teaches a certain concept, and in combination with the primary reference discloses the presently-claimed invention.

20. In addition, Applicant argues that Solomon does not teach or suggest to join two carrier foils such that respective security features are disposed in register to each other by stretching one of the foils in the longitudinal direction. However, Solomon provides that it is possible to maintain the desired alignment of a multilayered security document (i.e., a note) that is subject to stretching in the longitudinal direction by adjusting the position of the security features (i.e., the window) and that any misalignment can be detected and corrected for by adjusting the stretching that is occurring in the continuous web. It is noted that Solomon does not disclose all the features of the present claimed invention. However, Solomon is used as teaching reference for the longitudinal stretching of the multilayered security document, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 U.S.P.Q. 224, 226 (C.C.P.A. 1973); *In re Keller* 624 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Rather, this reference teaches

a certain concept, and in combination with the primary reference discloses the presently-claimed invention.

21. Finally, Applicant asserts that it is premature to comment on a preliminary double patenting objection. Therefore, the double patenting rejection that appears hereinabove stands.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date

of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/DJJ/

Examiner, Art Unit 1794

11/07/2008

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794